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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 310

FOURCO GLASS COMPANY,

Petitioner,

v.

TRANSMIRRA PRODUCTS CORP. and
ROBERT ARONSTEIN,

Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION

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Question Presented

Although petitioner's statement (Pet. p. 2) of the question presented avers that the corporate defendant (petitioner) has not infringed in the judicial district of this patent suit, it is to be noted that the Circuit Court of Appeals in the opening paragraph of the opinion of its learned Chief Justice expressly refrained from considering that phase of the lower court's rulings, such express reservation in itself constituting reason for the denial of certiorari herein.

Statement

Petitioner's "Statement" (Pet. pp. 2-5), is likewise inaccurate insofar as it states the lower court entered judgment of dismissal "after a full hearing on the merits" (Pet. pp. 3-4)—the proceedings below clearly indicate that respondents appeal to the Circuit Court of Appeals was in large part predicated on the failure of the lower court to accord respondents a hearing as prayed for, prior to its summary dismissal of the complaint; and, further, insofar as it states as a fact (Pet. p. 4) that respondents' motion for a remand "was found to be without merit" and was for that reason denied.

An examination of the record fails to reveal any holding that the motion to remand was "found to be without merit". Furthermore, the fact that the Court of Appeals specifically stated in its decision that it would not consider the ruling of the District Court with respect to the absence of local acts of infringement, confirms the viewpoint that no question of acts of infringement was decided on the merits by that court at any time.

In this connection, it is observed that petitioner has caused to be printed and submitted to this Court matter (R. pp. 23a-63a) which was not a part of the record on appeal to the Circuit Court of Appeals, and which therefore forms no proper part of the record herein.

POINT I

Review is not warranted because the question presented is not decisive of the issue of venue.

In the opening paragraph of the opinion of the learned Chief Justice, the Circuit Court of Appeals expressly pointed out (Pet. Appendix B, p. 3a) that, in view of other

aspects of its decision, it had not considered the lower court's ruling respecting the alleged absence of local acts of infringement. These questions of fact as well as of mixed law and fact, involving local acts of infringement, which could in any event sustain a finding of proper venue as laid, were thus expressly reserved and are still open. Under Title 28 U. S. Code § 1400(b), venue could properly be laid herein either in a district where the corporate defendant resides, or where it has a regular and established place of business and committed acts of infringement. Since these are alternative venue criteria, either alone would suffice. At bar, therefore, even if this Court should be disposed to consider the narrow legal question now desired to be tendered by petitioner, in a manner favorable to petitioner, the issue of venue would not thereby be resolved but would still remain open to await determination by the Court below of the questions of fact as well as of mixed law and fact which it specifically did not consider with respect to local acts of infringement. Under these circumstances, and in this posture of the case, review would be unjustified and certiorari should not be granted, prior to final judgment, merely to weigh what might at best be an academic question, hypothetically interesting but in no sense dispositive of the case itself nor even of the issue of venue.

In dealing with certified questions (and thus, *a fortiori*, applications for writs of certiorari) this Court stated in *Busby et al.* v. *Electric Utilities Employees Union, etc.*, 323 U. S. 72, 75:

> "We do not answer the question as to the effect of the second part of Rule 17(b), since the answer will be decisive of the case only in the event that a question of local law, not answered by the Court of Appeals and inappropriate for us to consider in the first instance, receives one rather than another answer. • • •"

Similarly at bar, the answer sought by petitioner could be decisive of the issue of venue only in the event that the Court of Appeals might possibly at some subsequent date determine factual and mixed factual and legal questions of local acts of infringement adversely to the respondents. Since those questions have expressly been left open by the Court of Appeals, even were petitioner to succeed in obtaining the decision for which it now presses, such determination could be rendered wholly academic by a subsequent decision of the Court below. Under these circumstances, review at this time as now demanded by the petitioner would not be warranted, and certiorari should therefore be denied.

POINT II

Review is not warranted upon the preliminary procedural point now tendered by petitioner.

This Court has repeatedly called attention to the purpose and extremely limited availability of the writ of certiorari as a method of review, to be employed only when there are special and important reasons therefor, and the reservation of its employment in cases prior to final judgment to those extraordinary cases justifying deviation from normal appellate processes.

> *Hamilton-Brown Shoe Co.* v. *Wolf Brothers & Co.*, 240 U. S. 251, 258;
> *American Construction Co.* v. *Jacksonville T. & K. W. Railway Co.*, 148 U. S. 372;
> *The Three Friends*, 166 U. S. 1;
> *The Conqueror*, 166 U. S. 110, 113;
> *Denner* v. *New York Trust Co.*, 229 U. S. 123, 133.

This is no such case. The case is neither extraordinary nor of imperative public importance, nor are there special or important reasons for review at this time, nor reasons

for deviating from normal appellate processes which are, of course, fully available to petitioner herein.

Although the existence of conflict among the circuits may in certain cases justify certiorari, by no means does it follow that certiorari will be automatically granted in all cases where conflict exists or where such conflict involves preliminary procedural, as distinguished from important substantive, questions of law. Even where conflict exists among the circuits, in the field of preliminary procedural questions, certiorari would be unwarranted because of such factors as the preliminary nature of the questions, the inconclusive character of the issues tendered for decision, and the lack of substantive importance of the matters involved—in this case, for example, at best, merely the insubstantial question of the particular federal circuit from which the case might ultimately reach this Court for review. If applications for writs of certiorari were to be entertained on this sort of preliminary procedural point, the outcome of which would in any event be inconclusive even as to the narrow issue of venue, then the floodgates to applications for writs of certiorari to this Court would be opened wide indeed.

Petitioner, while recognizing that the judgment below is not final, argues that the legal point it is attempting to tender to this Court for decision at this time is "*appropriate*" for review since it is claimed to be "fundamental to the further conduct of the case," (Pet. p. 9, "4"). Although certiorari will not be granted under the rules and practice of this Court merely because a question is asserted by a petitioner to be "appropriate" for review, a further reason to deny certiorari herein is that the decision below is not "fundamental to the further conduct of the case."

In support of its argument that although the judgment below is not final the issue attempted to be tendered is

"appropriate" for review "since the venue issue is fundamental to the further conduct of this case," petitioner cites three cases (Pet. p. 9, "4"). The case at bar is not comparable to those cases, which involved basic issues at the fundamental roots of the rights of the parties and directly affecting the ultimate merits. The first two cases cited (Pet. p. 9, "4") involved issues of sovereign immunity and whether the suits were actually against the United States, while the third case dealt with the proper elements in computing just compensation in condemnation proceedings involving the meaning and scope of a constitutional provision. There is nothing in those cases to support petitioner's characterization of the narrow venue question it wishes to tender for decision now, as one which is "fundamental to the further conduct of the case." The issue of venue, even in its limited scope as sought to be tendered herein by petitioner at this time, would in no sense decide the merits of this case nor affect the rights of the parties, nor indeed—as shown above—decide even the question of venue.

Since, therefore, there is here presented neither an extraordinary case nor a question fundamental to the further conduct of this case and there is no final judgment herein, review by this Court at this time is not warranted and the petition for certiorari should be denied.

POINT III

The decision below is so clearly justified that review by this Court is not warranted.

As stated in the opinion of the learned Chief Justice (R. 66a), the Second Circuit Court of Appeals expressly followed the decision of this Court in *Stonite Products Co.* v. *Melvin Lloyd Co.*, 315 U. S. 561, in holding that 28 U. S. C. § 1400(b) controlled venue herein. Likewise, upon the authority of the decision of this Court in *Ex parte*

Colleti, 337 U. S. 55, 61-71, the Court below held that there was a change in substance in the use of "resides" and that the definition contained in 28 U. S. C. § 1391(c) should now be applied to the word "resides" in 28 U. S. C. § 1400(b) so as to make corporations suable where they do business.

In its clearly justified conclusions, the unanimous Second Circuit Court of Appeals, as indicated in the brilliant opinion of its learned Chief Justice, by no means found itself alone. (See, for example, the unanimous decisions in *Dalton* v. *Shakespeare Co.*, 5 Cir., 196 F. 2d 469, and *Guiberson Corp.* v. *Garrett Oil Tools*, 5 Cir., 205 F. 2d 660, *certiorari denied* 346 U. S. 886, *rehearing denied* 346 U. S. 917.)

The plainly evident availability of a statutory definition, unrestricted in scope by its terms (while, it is to be noted, earlier subdivisions of the statute—namely subdivisions (a) and (b) of § 1391—specifically provide for exceptions), which through consistent language so readily lends itself to application to a section of law akin in subject-matter, should not be restricted in that application by straining to read into it an unexpressed prohibition which is not warranted by any orderly rule of construction and which would, in the practical light of ever-widening corporate activities remote from and unconcerned with the state of technical incorporation, disarm the patent holder in his efforts to protect the grant of rights he has received under the Constitution.

A corporation may not be realistically located in the state of its technical incorporation (a choice frequently dictated by certain advantageous financial, tax or legal considerations, rather than by the nature and extent of its corporate activities and liability-creation potential), but a corporation will, perforce, be found where it is doing business.

CONCLUSION

Certiorari is sought to review a mere preliminary procedural point, the decision of which would neither be fundamental to the further conduct of the case, nor in any way affect the merits of the case nor ultimate judgment therein, nor even determine the preliminary question of venue. Insufficient reason is shown for invoking certiorari under these circumstances, in deviation from normal appellate procedures fully available to petitioner. Moreover, the decision complained of is clearly justified legally. Under all of the circumstances, in the present posture of the case, upon the narrow and academic point tendered by petitioner, review by certiorari at this time by the highest Court of the land would be unwarranted. The petition for certiorari should be denied.

Respectfully submitted,

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